

03-31-03
16PH

Attorney Docket No. 50450.8038.US00

1634

Express Mail Label EV 057395844 US



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Weller, *et al.*

APPLICATION No.: 09/943,458

FILED: August 30, 2001

FOR: METHOD FOR ANALYSIS OF OLIGONUCLEOTIDE
ANALOGS

EXAMINER: Arun K. Chakrabarti

ART UNIT: 1634

CONF. No: 9454

**Information Disclosure Statement After First Office Action but
Before Final Action or Notice of Allowance – 37 CFR 1.97(c)**

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

1. Timing of Submission

The information transmitted herewith is being filed *after* three months of the filing date of this application or after the mailing date of the first Office action on the merits, whichever occurred last, but *before* the mailing date of either a final action under 37 CFR 1.113 or a Notice of Allowance under 37 CFR 1.311, whichever occurs first. The references listed on the enclosed Form PTO/SB/08A may be material to the examination of this application; the Examiner is requested to make them of record in the application.

2. Cited Information

☒ Copies of the following references are enclosed:

☒ All cited references

☐ References marked by asterisks

☐ The following:

3. Effect of Information Disclosure Statement (37 CFR 1.97(h))

This Information Disclosure Statement is not to be construed as a representation that: (i) a search has been made; (ii) additional information material to the examination of this application does not exist; (iii) the information, protocols, results and the like reported by third parties are accurate or enabling; or (iv) the cited information is, or is considered to be, material to patentability. In addition, applicant does not admit that any enclosed item of information constitutes prior

art to the subject invention and specifically reserves the right to demonstrate that any such reference is not prior art.

4. Fee Payment (37 CFR 1.97(c)) or Certification (37 CFR 1.97(e))

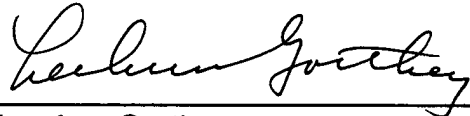
- ☒ Applicant submits that no fee is due in light of the following certification under 37 CFR 1.97(e) (check only one):
- ☒ In accordance with 37 CFR 1.97(e)(1), the undersigned hereby states that each item of information submitted herewith was cited in a communication from a foreign patent office in a counterpart foreign application not more than three months prior to this filing of this statement; or
- ☒ Please charge any underpayment for timely filing of this paper to Deposit Account No. 50-2207.

5. Patent Term Adjustment (37 CFR 1.704(d))

- ☐ The undersigned states that each item of information submitted herewith was cited in a communication from a foreign patent office in a counterpart application and that this communication was not received by any individual designated in 37 C.F.R. §1.56(c) more than thirty days prior to the filing of this statement. 37 C.F.R. §1.704(d).

Date: 3-27-03

Respectfully submitted,
Perkins Coie LLP



LeeAnn Gorthey
Registration No. 37,337

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INFORMATION DISCLOSURE STATEMENT BY APPLICANT

Form PTO-1449 (Modified)
(Use several sheets if necessary)

COMPLETE IF KNOWN

Application Number	09/943,458
Confirmation Number	9454
Filing Date	August 30, 2001
First Named Inventor	Dwight D. Weller
Group Art Unit	1634
Examiner Name	Arun Chakrabarti
Attorney Docket No.	50450.8038.US00

Sheet 1 of 1

U.S. PATENT DOCUMENTS

Examiner Initials*	Cite No.	U.S. Patent or Application		Name of Patentee or Inventor of Cited Document	Date of Publication or Filing Date of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear
		NUMBER	Kind Code (if known)			

FOREIGN PATENT DOCUMENTS

Examiner Initials*	Cite No.	Foreign Patent or Application			Name of Patentee or Applicant of Cited Document	Date of Publication or Filing Date of Cited Document	Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear	T
		Office	NUMBER	Kind Code (if known)				
		WO	02/18656		Copy of International Search Report dated 2/13/2003			
		WO	97/12995		Fuchs, <i>et al.</i>	4/10/97		
		WO	98/04571		Agrawal, <i>et al.</i>	2/5/98		
		WO	98/38334		Nie & Wu	9/3/98		

OTHER PRIOR ART-NON PATENT LITERATURE DOCUMENTS

Examiner Initials*	Cite No.	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume issue number(s), publisher, city and/or country where published.	T
		Carlsson, C., <i>et al.</i> , <i>Nature</i> <u>380</u> , (1996)	
		Orum, H., <i>et al.</i> , <i>BioTechniques</i> <u>19</u> (3):472-480 (1995)	
		Bio-Rad Laboratories, <i>Bio-Rad Technical Bulletin (Online)</i> pp. 1-4 (1998)	

EXAMINER

DATE CONSIDERED

*EXAMINER: Initial if reference considered, whether or not criteria is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to application(s).

BY030860.093

PATENT COOPERATION TREATY

From the INTERNATIONAL SEARCHING AUTHORITY

DOCKETED PCT

To:

PERKINS COIE LLP
Attn. Dehlinger, Peter J.
P.O. Box 2168
Menlo Park, California 94026
UNITED STATES OF AMERICA

FOR

NOTIFICATION OF TRANSMITTAL OF
THE INTERNATIONAL SEARCH REPORT
OR THE DECLARATION

PERKINS COIE LLP
INITIALS Q

(PCT Rule 44.1)

RECEIVED
JAN 06 2003
PERKINS COIE LLP

Date of mailing
(day/month/year)

27/12/2002

Applicant's or agent's file reference

50450-8038.WO

FOR FURTHER ACTION

See paragraphs 1 and 4 below

International application No.

PCT/US 01/27129

International filing date
(day/month/year)

30/08/2001

Applicant

AVI BIOPHARMA, INC.

1. ☒ The applicant is hereby notified that the International Search Report has been established and is transmitted herewith.

Filing of amendments and statement under Article 19:

The applicant is entitled, if he so wishes, to amend the claims of the International Application (see Rule 46):

When? The time limit for filing such amendments is normally 2 months from the date of transmittal of the International Search Report; however, for more details, see the notes on the accompanying sheet.

Where? Directly to the International Bureau of WIPO
34, chemin des Colombettes
1211 Geneva 20, Switzerland
Facsimile No.: (41-22) 740.14.35

For more detailed instructions, see the notes on the accompanying sheet.

2. ☐ The applicant is hereby notified that no International Search Report will be established and that the declaration under Article 17(2)(a) to that effect is transmitted herewith.

3. ☐ With regard to the protest against payment of (an) additional fee(s) under Rule 40.2, the applicant is notified that:

☐ the protest together with the decision thereon has been transmitted to the International Bureau together with the applicant's request to forward the texts of both the protest and the decision thereon to the designated Offices.

☐ no decision has been made yet on the protest; the applicant will be notified as soon as a decision is made.

4. **Further action(s):** The applicant is reminded of the following:

Shortly after **18 months** from the priority date, the international application will be published by the International Bureau. If the applicant wishes to avoid or postpone publication, a notice of withdrawal of the international application, or of the priority claim, must reach the International Bureau as provided in Rules 90bis.1 and 90bis.3, respectively, before the completion of the technical preparations for international publication.

Within **19 months** from the priority date, a demand for international preliminary examination must be filed if the applicant wishes to postpone the entry into the national phase until 30 months from the priority date (in some Offices even later).

Within **20 months** from the priority date, the applicant must perform the prescribed acts for entry into the national phase before all designated Offices which have not been elected in the demand or in a later election within 19 months from the priority date or could not be elected because they are not bound by Chapter II.

Name and mailing address of the International Searching Authority



European Patent Office, P.B. 5818 Patentlaan 2
NL-2280 HV Rijswijk
Tel. (+31-70) 340-2040, Tx. 31 651 epo nl,
Fax: (+31-70) 340-3016

Authorized officer

Anna S}lberg

NOTES TO FORM PCT/ISA/220

These Notes are intended to give the basic instructions concerning the filing of amendments under article 19. The Notes are based on the requirements of the Patent Cooperation Treaty, the Regulations and the Administrative Instructions under that Treaty. In case of discrepancy between these Notes and those requirements, the latter are applicable. For more detailed information, see also the PCT Applicant's Guide, a publication of WIPO.

In these Notes, "Article", "Rule", and "Section" refer to the provisions of the PCT, the PCT Regulations and the PCT Administrative Instructions respectively.

INSTRUCTIONS CONCERNING AMENDMENTS UNDER ARTICLE 19

The applicant has, after having received the international search report, one opportunity to amend the claims of the international application. It should however be emphasized that, since all parts of the international application (claims, description and drawings) may be amended during the international preliminary examination procedure, there is usually no need to file amendments of the claims under Article 19 except where, e.g. the applicant wants the latter to be published for the purposes of provisional protection or has another reason for amending the claims before international publication. Furthermore, it should be emphasized that provisional protection is available in some States only.

What parts of the international application may be amended?

Under Article 19, only the claims may be amended.

During the international phase, the claims may also be amended (or further amended) under Article 34 before the International Preliminary Examining Authority. The description and drawings may only be amended under Article 34 before the International Examining Authority.

Upon entry into the national phase, all parts of the international application may be amended under Article 28 or, where applicable, Article 41.

When?

Within 2 months from the date of transmittal of the international search report or 16 months from the priority date, whichever time limit expires later. It should be noted, however, that the amendments will be considered as having been received on time if they are received by the International Bureau after the expiration of the applicable time limit but before the completion of the technical preparations for international publication (Rule 46.1).

Where not to file the amendments?

The amendments may only be filed with the International Bureau and not with the receiving Office or the International Searching Authority (Rule 46.2).

Where a demand for international preliminary examination has been/is filed, see below.

How?

Either by cancelling one or more entire claims, by adding one or more new claims or by amending the text of one or more of the claims as filed.

A replacement sheet must be submitted for each sheet of the claims which, on account of an amendment or amendments, differs from the sheet originally filed.

All the claims appearing on a replacement sheet must be numbered in Arabic numerals. Where a claim is cancelled, no renumbering of the other claims is required. In all cases where claims are renumbered, they must be renumbered consecutively (Administrative Instructions, Section 205(b)).

The amendments must be made in the language in which the international application is to be published.

What documents must/may accompany the amendments?

Letter (Section 205(b)):

The amendments must be submitted with a letter.

The letter will not be published with the international application and the amended claims. It should not be confused with the "Statement under Article 19(1)" (see below, under "Statement under Article 19(1)").

The letter must be in English or French, at the choice of the applicant. However, if the language of the international application is English, the letter must be in English; if the language of the international application is French, the letter must be in French.

NOTES TO FORM PCT/ISA/220 (continued)

The letter must indicate the differences between the claims as filed and the claims as amended. It must, in particular, indicate, in connection with each claim appearing in the international application (it being understood that identical indications concerning several claims may be grouped), whether

- (i) the claim is unchanged;
- (ii) the claim is cancelled;
- (iii) the claim is new;
- (iv) the claim replaces one or more claims as filed;
- (v) the claim is the result of the division of a claim as filed.

The following examples illustrate the manner in which amendments must be explained in the accompanying letter:

1. [Where originally there were 48 claims and after amendment of some claims there are 51]:
"Claims 1 to 29, 31, 32, 34, 35, 37 to 48 replaced by amended claims bearing the same numbers; claims 30, 33 and 36 unchanged; new claims 49 to 51 added."
2. [Where originally there were 15 claims and after amendment of all claims there are 11]:
"Claims 1 to 15 replaced by amended claims 1 to 11."
3. [Where originally there were 14 claims and the amendments consist in cancelling some claims and in adding new claims]:
"Claims 1 to 6 and 14 unchanged; claims 7 to 13 cancelled; new claims 15, 16 and 17 added." or
"Claims 7 to 13 cancelled; new claims 15, 16 and 17 added; all other claims unchanged."
4. [Where various kinds of amendments are made]:
"Claims 1-10 unchanged; claims 11 to 13, 18 and 19 cancelled; claims 14, 15 and 16 replaced by amended claim 14; claim 17 subdivided into amended claims 15, 16 and 17; new claims 20 and 21 added."

"Statement under article 19(1)" (Rule 46.4)

The amendments may be accompanied by a statement explaining the amendments and indicating any impact that such amendments might have on the description and the drawings (which cannot be amended under Article 19(1)).

The statement will be published with the international application and the amended claims.

It must be in the language in which the international application is to be published.

It must be brief, not exceeding 500 words if in English or if translated into English.

It should not be confused with and does not replace the letter indicating the differences between the claims as filed and as amended. It must be filed on a separate sheet and must be identified as such by a heading, preferably by using the words "Statement under Article 19(1)."

It may not contain any disparaging comments on the international search report or the relevance of citations contained in that report. Reference to citations, relevant to a given claim, contained in the international search report may be made only in connection with an amendment of that claim.

Consequence if a demand for international preliminary examination has already been filed

If, at the time of filing any amendments under Article 19, a demand for international preliminary examination has already been submitted, the applicant must preferably, at the same time of filing the amendments with the International Bureau, also file a copy of such amendments with the International Preliminary Examining Authority (see Rule 62.2(a), first sentence).

Consequence with regard to translation of the international application for entry into the national phase

The applicant's attention is drawn to the fact that, where upon entry into the national phase, a translation of the claims as amended under Article 19 may have to be furnished to the designated/elected Offices, instead of, or in addition to, the translation of the claims as filed.

For further details on the requirements of each designated/elected Office, see Volume II of the PCT Applicant's Guide.

PATENT COOPERATION TREATY

PCT

INTERNATIONAL SEARCH REPORT

(PCT Article 18 and Rules 43 and 44)

Applicant's or agent's file reference 50450-8038.W0	FOR FURTHER ACTION see Notification of Transmittal of International Search Report (Form PCT/ISA/220) as well as, where applicable, item 5 below.	
International application No. PCT/US 01/ 27129	International filing date (day/month/year) 30/08/2001	(Earliest) Priority Date (day/month/year) 30/08/2000
Applicant AVI BIOPHARMA, INC.		

This International Search Report has been prepared by this International Searching Authority and is transmitted to the applicant according to Article 18. A copy is being transmitted to the International Bureau.

This International Search Report consists of a total of 4 sheets.



It is also accompanied by a copy of each prior art document cited in this report.

1. Basis of the report

- a. With regard to the **language**, the international search was carried out on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.



the international search was carried out on the basis of a translation of the international application furnished to this Authority (Rule 23.1(b)).

- b. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international search was carried out on the basis of the sequence listing :



contained in the international application in written form.



filed together with the international application in computer readable form.



furnished subsequently to this Authority in written form.



furnished subsequently to this Authority in computer readable form.



the statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.



the statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished

2. ☐ **Certain claims were found unsearchable** (See Box I).

3. ☐ **Unity of invention is lacking** (see Box II).

4. With regard to the **title**,



the text is approved as submitted by the applicant.



the text has been established by this Authority to read as follows:

5. With regard to the **abstract**,



the text is approved as submitted by the applicant.



the text has been established, according to Rule 38.2(b), by this Authority as it appears in Box III. The applicant may, within one month from the date of mailing of this international search report, submit comments to this Authority.

6. The figure of the **drawings** to be published with the abstract is Figure No.



as suggested by the applicant.



because the applicant failed to suggest a figure.



because this figure better characterizes the invention.

5A _____



None of the figures.

INTERNATIONAL SEARCH REPORT

International Application No

PCT/US 01/27129

A. CLASSIFICATION OF SUBJECT MATTER

IPC 7 C12Q1/68 C07H21/00 C07H1/06

According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

IPC 7 C12Q C07H

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the international search (name of data base and, where practical, search terms used)

EPO-Internal, WPI Data, PAJ, MEDLINE, BIOSIS, EMBASE, CHEM ABS Data

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	WO 97 12995 A (PERSEPTIVE BIOSYSTEMS INC) 10 April 1997 (1997-04-10) see whole doc. esp. claims and examples ---	1-27
X	WO 98 04571 A (AGRAWAL SUDHIR ;HABUS IVAN (US); HYBRIDON INC (US); KANDIMALLA EKA) 5 February 1998 (1998-02-05) see whole doc. esp. claims and p. 12, .19-p.13, l.16; p. 15, l.1-12 ---	1-27
X	WO 98 38334 A (LORNE PARK RESEARCH INC) 3 September 1998 (1998-09-03) see whole doc. esp. claims and p.8, 4. par. --- -/--	1-27

☒ Further documents are listed in the continuation of box C.☒ Patent family members are listed in annex.

* Special categories of cited documents:

- *A* document defining the general state of the art which is not considered to be of particular relevance
- *E* earlier document but published on or after the international filing date
- *L* document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)
- *O* document referring to an oral disclosure, use, exhibition or other means
- *P* document published prior to the international filing date but later than the priority date claimed

- *T* later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention
- *X* document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone
- *Y* document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art.
- *&* document member of the same patent family

Date of the actual completion of the international search

18 December 2002

Date of mailing of the international search report

27/12/2002

Name and mailing address of the ISA

European Patent Office, P.B. 5818 Patentlaan 2
NL - 2280 HV Rijswijk
Tel. (+31-70) 340-2040, Tx. 31 651 epo nl,
Fax: (+31-70) 340-3016

Authorized officer

Mueller, F

INTERNATIONAL SEARCH REPORT

International Application No

PCT/US 01/27129

C.(Continuation) DOCUMENTS CONSIDERED TO BE RELEVANT

Category *	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X f	CARLSSON C ET AL: "SCREENING FOR GENETIC MUTATIONS" NATURE, MACMILLAN JOURNALS LTD. LONDON, GB, vol. 380, 21 March 1996 (1996-03-21), page 207 XP000857932 ISSN: 0028-0836 the whole document ---	1-27
X f	ORUM H ET AL: "SEQUENCE-SPECIFIC PURIFICATION OF NUCLEIC ACIDS BY PNA-CONTROLLED HYBRID SELECTION" BIOTECHNIQUES, EATON PUBLISHING, NATICK, US, vol. 19, no. 3, 1 September 1995 (1995-09-01), pages 472-480, XP000541925 ISSN: 0736-6205 the whole document ---	1-27
A f	BIO-RAD LABORATORIES: "Nucleotide and oligonucleotide separations on an UNO Q1 ion exchange column" BIO-RAD TECHNICAL BULLETIN (ONLINE), XX, XX, 24 July 1998 (1998-07-24), pages 1-4, XP002129107 -----	

INTERNATIONAL SEARCH REPORT

Information on patent family members

International Application No

PCT/US 01/27129

Patent document cited in search report		Publication date	Patent family member(s)	Publication date
WO 9712995	A	10-04-1997	EP 0854937 A1	29-07-1998
			JP 11512617 T	02-11-1999
			WO 9712995 A1	10-04-1997
			US 2002012902 A1	31-01-2002
WO 9804571	A	05-02-1998	US 5912332 A	15-06-1999
			AU 3672797 A	20-02-1998
			WO 9804571 A2	05-02-1998
WO 9838334	A	03-09-1998	US 6060242 A	09-05-2000
			AU 736701 B2	02-08-2001
			AU 6513598 A	18-09-1998
			EP 0975800 A1	02-02-2000
			WO 9838334 A1	03-09-1998
			JP 2001514497 T	11-09-2001
			TW 389791 B	11-05-2000
			US 6046004 A	04-04-2000
			US 6251591 B1	26-06-2001
			US 5846729 A	08-12-1998
			ZA 9801660 A	25-01-1999